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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/332,317	06/14/99	BENNETT	J P93-00-DD

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EXAMINER

TRAN, T

ART UNIT

PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/332,317

Applicant(s)
Bennett et al.

Examiner
Tongoc Tran

Group Art Unit
2161



☒ Responsive to communication(s) filed on Jun 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 6-27 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is in response to Applicant's application filed on 8/31/1998 which was allowed but later withdrawn from issue under 37 CFR 1.313(b)(3).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 6-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griggs (U.S. Patent No. 4,435,617) in view of Baker (U.S. Patent No. 6,122,613).

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Regarding to claim 6, Griggs discloses a transcription system used to convert words spoken during a transcription proceeding to a textual form for real time display, the transcription system comprising:

a transcriber that produces, in real time, transcript text representative of spoken words (see col. 2, lines 14-20, col. 6, lines 19-22);

stores data representative at least one document relating to the transcription proceeding (see Fig. 1, item 36).

Griggs does not explicitly discloses:

a user input device supporting the selection of the at least one document and;

a screen that displays the transcript text as it is produced and the at least one document for viewing.

However, Baker discloses storing data representative at least one document...(see Fig. 1, 113, Fig. 2, word processor, it is inherently required for data to be stored in the word processor);

a user input device supporting the selection of the at least one document (see Fig. 1, items 103, 105, 117 and 113, Fig. 2, word processor);

and a screen that displays the transcript text as it is produced and the at least one document for viewing (see Fig. 1, item 107).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Griggs's transcription system used to convert words spoken

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into text with Baker's word processing system for processing or storing documents received from the transcription system.

Regarding to claim 7, Griggs discloses the transcription system of claim 6 but does not disclose further comprising a processor that responds to the user input device as the transcriber produces the transcript text by associating at least a portion of the transcript text with the at least one document.

However, Baker discloses transcript text stored in a word processor (see Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Griggs' transcription system and Baker's word processor to associate portion of Griggs's transcription text with stored document in Baker's processor for the benefit of performing document processing.

Regarding to claims 8 and 17, Griggs disclose a transcription system of claim 7 where in the transcript text is stored in data storage (or memory) (see Fig. 1, item 36).

Regarding to claims 9 and 18, the claimed invention contain similar limitation which is discussed in claim 7 and therefore the same rejection applied.

Regarding to claim 10, Griggs discloses a transcription system of claim 6 but does not explicitly discloses the user input device supports creation of an annotation, and further comprising a processor that responds to the user input device by associating the annotation with the at least one document.

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However, Official Notice is taken that user input device supports creation of an annotation, and a processor that responds to the user input device by associating the annotation with the least one document is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include these word processing capability to Griggs' transcription system for processing or storing documents received from the transcription system.

Regarding to claim 11, Griggs discloses a transcription system of claim 6 but does not explicitly discloses wherein the user input device supports real time modification of the selection of the at least one document.

However, Official Notice is taken that real time modification of the selection of at least one document is old and well known in a word processing application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include word processing feature to Griggs' transcription system for processing documents received from the transcription system.

Regarding to claim 12, Griggs discloses a transcription system of claim 7 further comprising a terminal, and wherein the terminal comprises the processor (see Fig. 1, item 34 and col. 2, lines 40-55).

Regarding to claim 13, Griggs discloses a transcription system used to convert words spoken during a transcription proceeding to a textual form for real time display, the transcription system comprising:

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a transcriber that produces, in real time, transcript text representative of spoken words
(see col. 2, lines 14-20, col. 6, lines 19-22);

a communication link (see col. 12, lines 55-56);

a screen (see col. 6, line 52, display);

data storage that stores data representative of at least one document relating to the
transcription proceeding (see Fig. 1, item 36);

Griggs does not explicitly disclose:

a processor that receives the transcript text in real time from the transcriber via a
communication link; and

the processor, as the transcriber produces the transcript text, directing display on the
screen of the transcript text and the at least one document for viewing.

However, Baker discloses storing data representative at least one document...(see Fig. 1,
113, Fig. 2, word processor, it is inherently required for data to be stored in the word processor);

a processor that receives the transcript text in real time from the transcriber via a
communication link (see col. 3, lines 25-35);

a processor, as the transcriber produces the transcript text, directing display on the screen
of the transcript text and the at least one document for viewing (see Fig. 2, col. 3, lines 25-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the
invention was made to incorporate Griggs's transcription system used to convert words spoken

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into text with Baker's word processing system for processing or storing documents received from the transcription system.

Regarding to claim 14, the claimed invention contains similar limitation already discussed in claim 1 and therefore the same rejection applied.

Regarding to claims 15 and 16, the claimed invention contains similar limitation of claim 7 and therefore the same rejection applied.

Regarding to claim 19, the claimed invention is similar to the limitation of claim 10 and therefore the same rejection applied.

Regarding to claim 20, the claimed invention is similar to the limitation of claim 11 and therefore the same rejection applied.

Regarding to claim 21, the claimed invention is similar to the limitation of claim 12 and therefore the same rejection applied.

Regarding to claim 22, Griggs discloses a method that transcribes spoken words into text and display the transcript text on the screen for real time viewing, the method utilizing at least a screen, data storage, and a user input device (see col. 2, lines 11-21).

Griggs does not explicitly discloses said method comprises:

converting, using the stenographic system, representations of spoken words to transcript text in real time;

However, Official Notice is taken that converting, using the stenographic system, representations of spoken words to transcript text in real time is old and well known. It would

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have been obvious to one of ordinary skill in the art at the time the invention was made to include a stenographic system that converts spoken words to transcript text in real time in Griggs' transcription system for the benefit of the widely used of stenographic system in the court.

Furthermore, Griggs does not explicitly disclose accepting, via the user input device, at least one input selecting a first document stored in data storage; and

display on the screen the document.

However, Baker discloses accepting, via the user input device, at least one input selecting a first document stored in data storage (see Fig. 2)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Griggs's transcription system used to convert words spoken into text with Baker's word processing system for processing or storing documents received from the transcription system.

Regarding to claim 23, the claimed invention contains the similar limitation of claim 15 and therefore the same rejection applied.

Regarding to claim 24, the claimed invention contains the similar limitation of claim 22 and therefore the same rejection applied (it is inherent that a word processing application can store at least one document and user can select a plurality of documents stored in the data storage).

Regarding to claim 25, the claimed invention contains the similar limitation of claim 15 and therefore the same rejection applied.

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Regarding to claims 26 and 27, the claimed invention contains the similar limitations already discussed in claim 22 and 23 (storage mean for transcript text and display mean that associate transcript text with at least one documents) and therefore the same rejection applied.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 6, 13 and 22 are rejected under the judicially created doctrine of double patenting over claims 1 of U. S. Patent No. 5,444,615 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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Regarding to claims 6 of the instant application and claim 1 of the patent, all limitations set forth in claim 6 are found in claim 1 of the patent.

Claims 6 and 13 of the instant application disclose:

a transcription system used to convert words spoken during a transcription proceeding to text form for real time display, comprising:

- a) a transcriber..., in real time, transcript text...of spoken words;
- b) a data storage...relating to the transcription proceeding;
- c) a user input device supporting the selection of at least one document;
- d) a screen...at least one document viewing.

Claim 1 of the patent discloses:

a transcription system used to convert words spoken during a transcription proceeding...(col. 27, lines 8-10)

- a) a transcriber..., in real time, transcript text...of spoken words (col. 27, lines 11-12);
- b) a data storage...relating to the transcription proceeding (col. 27, lines 19-22, storage mean is inherently required in order for the information to be classified).
- c) a user input device support the selection of at least one document (see col. 27, lines 16-19, Fig. 5a-5f).
- d) a screen...at least one document viewing (col. 27, lines 19-22, Fig. 5a-5f).

Dependent claims 7-12, 14-21 are also rejected because by their dependence they contains languages of the base claims.

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Regarding to claim 22 of the instant application and claim 1 of the patent, all limitations set forth in claim 22 already discussed in claims 6 and 23 above are found in claim 1 of the patent except claim 1 of the patent does not disclose "converting, using the stenographic system, representing of spoken words to transcript text in real time".

However, Official Notice is taken that said feature of converting using the stenographic system is old and well known. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add said feature to Griggs because of the widely used of stenographical system in the court.

Dependent claims 23-27 are also rejected because by their dependence they contain language of the base claim.

7. Claims 6, 13 and 22 are rejected under the judicially created doctrine of double patenting over claims 1 of **U. S. Patent No. 5,815,392** since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Regarding to claims 6 and 13 of the instant application and claim 1 of the patent, all limitations set forth in claim 6 are found in claim 1 of the patent.

Claims 6 and 13 of the instant application disclose:

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a transcription system used to convert words spoken during a transcription proceeding to text form for real time display, comprising:

- a) a transcriber..., in real time, transcript text...of spoken words;
- b) a data storage...relating to the transcription proceeding;
- c) a user input device supporting the selection of at least one document;
- d) a screen...at least one document viewing.

Claim 1 of the patent discloses:

a transcription system used to convert words spoken during a transcription proceeding...(col. 26, lines 7-9)

- a) a transcriber..., in real time, transcript text...of spoken words (col. 26, lines 7-9);
- b) a data storage...relating to the transcription proceeding (col. 26, lines 16-17).
- c) a user input device support the selection of at least one document (see col. 26, lines 12-14, identify attempt - selection of document, enter item into evident-input mean is inherent in order for item to be entered).
- d) a screen or display...at least one document viewing (col. 26, lines 19-21).

Dependent claims 7-12, 14-21 are also rejected because by their dependence they contains the language of the rejected base claim.

Regarding to claim 22 of the instant application and claim 1 of the patent, all limitations set forth in claim 22 already discussed in claims 6 and 23 above are found in claim 1 of the patent

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except claim 1 of the patent does not disclose "converting, using the stenographic system, representing of spoken words to transcript text in real time".

However, Official Notice is taken that said feature of converting using the stenographic system is old and well known. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add said feature to Griggs because of the widely used of stenographical system in the court.

Dependent claims 23-27 are also rejected because by their dependence they contain language of the base claim.

8. Claims 6, 13 and 22 are rejected under the judicially created doctrine of double patenting over claims 1 of **U. S. Patent No. 5,940,800** since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Regarding to claims 6 of the instant application and claim 1 of the patent, all limitations set forth in claim 6 are found in claim 1 of the patent.

Claims 6 and 13 of the instant application disclose:

a transcription system used to convert words spoken during a transcription proceeding to text form for real time display, comprising:

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- a) a transcriber...,in real time, transcript text...of spoken words;
- b) a data storage...relating to the transcription proceeding;
- c) a user input device supporting the selection of at least one document;
- d) a screen...at least one document viewing.

Claim 1 of the patent discloses:

a transcription system used to convert words spoken during a transcription proceeding...(col. 25, lines 52-55)

- a) a transcriber..., in real time, transcript text...of spoken words (col. 25, lines 56-57);
- b) a data storage...relating to the transcription proceeding (col. 25, lines 59-61, storage mean is inherently required in order for the information to be related to a list of issue categories).
- c) a user input device support the selection of at least one document (see col. 25, lines 59-61).
- d) a screen...at least one document viewing (col. 25, lines 61-62).

Dependent claims 7-12, 14-21 are also rejected because by their dependence they contains languages of the base claims.

Regarding to claim 22 of the instant application and claim 1 of the patent, all limitations set forth in claim 22 already discussed in claims 6 and 23 above are found in claim 1 of the patent except claim 1 of the patent does not discloses "converting, using the stenographic system, representing of spoken words to transcript text in real time".

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However, Official Notice is taken that said feature of converting using the stenographic system is old and well known. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add said feature to Griggs because of the widely used of stenographical system in the court.

Dependent claims 23-27 are also rejected because by their dependence they contain language of the base claim.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

8. Claims 6-27 are rejected.
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - Holt et al. discloses a word tagging and editing system for speech recognition.
 - Shipp discloses a voice controlled medical text and image reporting system which includes a word processor module.
 - Kahn et al. discloses a system and method for automating transcription services.
10. **Any response to this action should be mailed to:**

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-0040, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

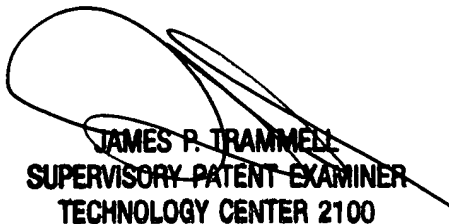
Hand-delivered responses should be brought to Crystal Park II, 2021
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran, whose telephone number is (703) 305-8967 and whose e-mail address is Tongoc.Tran@uspto.gov. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768. The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

TT
31Oct00


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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